

REMARKS

Claims 1-32 are pending in the present application. Claims 1, 9, 17, and 25 have been amended. Claims 33 and 34 have been added. Reconsideration of the claims is respectfully requested.

I. 35 U.S.C. § 112, Second Paragraph

The examiner rejects claims 5, 13, 21, and 29 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention. This rejection is respectfully traversed.

The examiner states that:

Regarding claims 5, 13, 21 and 29, the phrase "similar to" or "the like" renders the claims(s) indefinite because the claims(s) include(s) elements not actually disclosed (those encompassed by "similar to" or "the like"), thereby rendering the scope of the claims(s) unascertainable. See MPEP § 2173.05(d).

Office Action of December 7, 2004, p. 2.

Claims 5, 13, 31, and 29 are definite because the scope of the term "similar to," while broad, is definite and ascertainable. Applicant accurately describes the nature of the term "similar to" vis-à-vis the claims in the specification. Specifically, Applicant states that,

If desired, the result may be a password that is *similar to* the user's preferred word. In that case, initial translation of the user's preferred word, block 350, may involve only substituting a character for another character. As an example of substituting numerals for letters, a preferred word, "BIGBLUE," could be changed to "B1GB1UE." As an example of substituting special characters for letters, a preferred word, "Porsche," could be changed to "Por\$che." Here, the special character "\$" is substituted for the letter "s." Any special character that is recognizable by the target application could be used.

Specification, p. 7, l. 21 through p. 8, l. 3 (emphasis added).

The term "similar to" is broad in the sense that a very large number of individual small changes may be made to a password, even though one of ordinary skill would instantly recognize that a particular small change would result in a password that is

"similar to" the original password. For this reason, the term "similar to" as used in claim 1 is definite because infringement could clearly be ascertainable. Thus, the term "similar to" as used in claim 1 is analogous to broad claim terms that have been held to be definite, such as the term "about." W.L. Gore & Assoc., Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983) and MPEP § 2173.05(b).

In addition, the claims do not use the term "the like," to which the examiner appears to compare the claimed term "similar to." Likewise, the term "similar to" does not convey the same meaning as "the like." The term "the like" is unascertainable and for this reason is vague, as described in MPEP § 2173.05(d). However, the term "similar to" as used in claim 1 is ascertainable by one of ordinary skill and is ascertainable for purposes of determining infringement. Thus, claims 5, 13, 21, and 29 are definite.

II. 35 U.S.C. § 102. Anticipation

The examiner rejects claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29, and 30 as anticipated by, or in the alternative, as obvious over Guski et al., Authentication System Using One-Time Passwords, U.S. Patent 5,592,553 (Jan. 7, 1997). This rejection is respectfully traversed. The examiner asserts that:

As per claim 1, 9, 17 and 25, Guski teaches a method of generating a password, said method comprising:

receiving a preferred word from a user (Guski: see for example, Abstract Line 1-13 and Column 3 Line 57-60: Guski teaches the non-time-dependent information that ultimately generates the desired password is preferably derived from the information such as a user ID or application (Examiner notes "preferably" – could also be something else as user preferred), which is qualified to serve as a simple/preferred word);

translating said preferred word to produce a password; and providing said password to an application (Guski: see for example, Column 11 Line 1 & Table 1 and Column 3 Line 18-36: The application is the target application as taught by Guski);

wherein said preferred word is not stored (Guski: see for example, Figure 3 Element 320: The preferred word is transported over to the server at each time of password validation process);

said password is not stored (Guski: see for example, Column 3 Line 18-36 & Figure 3: One-time password is time-dependent and is not stored at the user/client side); and

said password complies with said application's required password format (Guski: see for example, Column 9 Line 49-50: A legal password should evidently comply with the password format).

Office Action of December 7, 2004, pp. 3-4.

The examiner misapprehends Guski. Regarding claim 1, Guski does not anticipate claim 1 because Guski does not show the limitations emphasized below:

1. A method of generating a password, said method comprising:
 - receiving a preferred word from a user;
 - translating said preferred word to produce a password; and*
 - providing said password to an application;wherein
 - said preferred word is not stored;
 - said password is not stored; and
 - said password complies with said application's required password format.

Guski does not show the limitation of "translating said preferred word to produce a password." The examiner asserts otherwise, citing the line "character translation" from column 11, line 1 of Guski and citing Table 11 shown in columns 11 and 12 of Guski.

The examiner also cites column 3, lines 18-36, which provides as follows:

The password is presented to an authenticator, which is typically located at an authenticating node to which the password is transmitted from the requesting node. The authenticator regenerates the time-dependent information from the password by (1) regenerating the authentication parameter from the password presented to the authenticator using the inverse of the second transformation and then (2) regenerating the time-dependent information from the authentication parameter using the inverse of the first transformation.

The authenticator compares the regenerated time-dependent information with reference time-dependent information and grants access to a resource in accordance with the comparison of the regenerated time-dependent information with the reference time-dependent information. More specifically [sic], if the regenerated time value is within a predetermined tolerance of the original time value, the authentication request is granted; otherwise, it is denied.

Guski, col. 3, ll. 18-36. However, none of the cited text shows or suggests the claimed limitation.

The text cited from column 3 discusses regenerating time-dependent information and using an authenticator to compare the regenerated time-dependent information with reference time-dependent information. The text from column 3 does not state or suggest that a preferred word is translated to produce a password. Moreover, Table 1 of Guski and the accompanying text merely show a method of translating 32-bit authentication parameters into an 8-bit alphanumeric character.

However, the authentication parameter is not a password or a preferred word. Instead, the authenticating parameter appears to be generated as a function of the user ID, application ID, sign-on key and time/date, as follows:

Password generator 300 is invoked when a user wishes to access a host application. When invoked, the password generator generates a one-time password 310 as a function of the user ID 302, application ID 304, signon key 306 and time/date 308. Password 310 is transmitted to the authenticating node 104, together with the user ID 302 and application ID 304, as part of a signon request 320.

Guski, col. 6, ll. 35-41. None of these items is a preferred word. Even the sign-on key is merely a key used for the *encryptions*. As described by Guski the "...signon key (K) 306 [is] used as a key for the encryptions to be described..." Guski, col. 6, ll. 30-32.

The only time that a user enters a password vis-à-vis Guski's methods is when the user signs into the LAN, as shown by the following citation from Guski:

The authentication sequence on system 200 is as follows. A workstation user stationed at client workstation 202 first authenticates himself to the LAN 210 by entering his LAN security server authentication password. (The method for authenticating the user to the LAN 210 is outside the purview of this invention; any of several methods well known in the art, as well as that disclosed in the present application, may be used.)

Guski, col. 7, ll. 21-28. Guski is specific that this password is outside the purview of his invention. Moreover, this disclosure is insufficient to show or suggest the limitation of translating a preferred word as claimed. In addition, Guski does not elsewhere translate a password, or anything else that can be construed to be a "preferred word." Thus, Guski does not show the limitation of "translating said preferred word to produce a password." Accordingly, Guski does not anticipate claim 1.

Furthermore, Guski is unrelated to applicant's claim except to the extent that Guski is concerned with generating passwords. Guski generates random passwords every

second using a user ID, time and date information, and an application ID. Thus, Guski does not work in an environment in which a particular application could have its own password. Accordingly, Guski is not addressing the particular problem addressed by Applicants' claims. Because Guski is unrelated to the claimed method and does not show or suggest all of the limitations of claim 1, Guski does not anticipate claim 1.

Independent claims 9, 17, 25 all contain similar limitations to those in claim 1. Therefore, Guski also does not anticipate these claims.

In addition, the examiner ignores limitations of claims 9, 17, and 25. These claims all provide for receiving input from a user specifying a password format. The examiner has failed to show how Guski shows this limitation. Moreover, Guski does not show or suggest receiving input specifying a password format. Thus, Guski does not anticipate claims 9, 17, and 25.

In addition, because claims 2, 3, 5, 6, 10, 11, 13, 14, 18, 19, 21, 22, 26, 27, 29, and 30 depend from claims 9, 17, and 25 accordingly, the same distinctions between Guski and the claimed invention in claim 1 can be made for these claims. Additionally, these claims claim other additional combinations of features not suggested by the reference. For example, Guski does not show or suggest "wherein said password is similar to said preferred word," as claimed in claim 5, because Guski is interested in using very different passwords that change very quickly.

Guski does not show or suggest all of the limitations of the rejected claims. Therefore, the rejection of claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29, and 30 under 35 U.S.C. § 102 has been overcome.

Furthermore, Guski does not teach, suggest, or give any incentive to make the needed changes to reach the presently claimed invention. As stated above, Guski does not work in an environment in which a particular application could have its own password. Because Guski does not address the particular problem addressed by Applicants' claims, Applicants' claims are non-obvious in view of Guski. Furthermore, Guski actually teaches away from the presently claimed invention because it teaches using rapidly changing dissimilar passwords generated independently of an application, as opposed to translating a preferred word to produce a password, wherein said password complies with said application's required password format, as in the presently claimed

invention. Absent the examiner pointing out some pre-existing teaching or incentive to implement Guski and this feature, one of ordinary skill in the art would not be led to modify Guski to reach the present invention when the reference is examined as a whole. Absent some teaching, suggestion, or incentive to modify Guski in this manner, the presently claimed invention can be reached only through an improper use of hindsight using the applicants' disclosure as a template to make the necessary changes to reach the claimed invention.

III. 35 U.S.C. § 103, Obviousness

III.A Rejection of Claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29, and 30

In addition to the anticipation rejection, the examiner rejects claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29, and 30 as being alternatively obvious over Guski. Guski does not show or suggest all of the limitations of these claims, as shown above. Thus, the proposed combination does not result in the claimed inventions. Accordingly, the examiner has failed to state prima facie obviousness rejections.

In addition, the examiner provided no motivation to modify Guski and provided no reason why the claims would be obvious over Guski if not anticipated by Guski. Thus, the examiner has again failed to state prima facie obviousness rejections.

In addition, the claims are non-obvious in view of Guski. Guski is sufficiently different from the claimed inventions that no one of ordinary skill would be motivated to modify Guski to achieve the claimed inventions. Guski is directed to generating random passwords that change at a rapid rate. Guski does not work in an environment in which a particular application could have its own password. Furthermore, Guski does not discuss translating a preferred word into a password. Given the vast number of passwords generated by Guski, and given that Guski would not benefit by performing this claimed step, no reason exists to modify Guski to perform this claimed step. Thus, Guski does not address the particular problem addressed by Applicants' claims. In addition, one of ordinary skill would have to depart greatly from the teachings of Guski to achieve the claimed inventions. Accordingly, one of ordinary skill would have no reason or motivation to modify Guski to achieve the claimed inventions. Thus, the claims are non-obvious over Guski.

Moreover, Guski is relatively old in the arts of computers, networks, and security for computers and computer networks. Guski issued in 1997, and in the intervening eight years no one has proposed or suggested the claimed invention except for Applicants. Given the extremely rapid pace of technological development in these areas and given the value of the claimed inventions, had the claims been obvious then someone already would have shown, suggested, or created the claimed inventions. Because no one other than Applicant and the examiner has done so, the claims are non-obvious.

Similarly, the examiner must have used impermissible hindsight when fashioning the obviousness rejection. Given that no one has suggested the claimed inventions in the intervening eight years, except for the examiner and Applicants in this application, the examiner must have used impermissible hindsight using Applicants' application as a template when fashioning the obviousness rejections. Thus, the examiner has again failed to state prima facie obviousness rejections of claims 1-3, 5, 6, 9-11, 13, 14, 17-19, 21, 22, 25-27, 29, and 30.

III.B Rejection of Claims 4, 7, 8, 12, 15, 16, 20, 23, 24, 28, 31, and 32

The examiner rejects claims 4, 7, 8, 12, 15, 16, 20, 23, 34, 28, 31, and 32 under 35 U.S.C. § 103 as being unpatentable over Guski in view of Audebert et al., System and Method for User Authentication Having Clock Synchronization, U.S. Patent 5,887,065 (Mar. 23, 1999). This rejection is respectfully traversed.

Regarding claims 7, 15, 23, and 31, the examiner asserts that:

As per claim 7, 15, 23 and 31, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski does not disclose expressly said translating is accomplished at least in part by a smart card.

Audebert teaches said translating is accomplished at least in part by a smart card (Audebert: see for example, Figure 9 and Column 17 Line 13-19).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to combine the teaching of Audebert within the system of Guski because (s) Guski teaches a password generating / translating method that can be used between two computers and (b) Audebert teaches a method that a smart card can take a part in generating the password to simplify the

software implementation on the PC (Audebert: see for example, Column 17 Line 13-19).
Office Action of December 7, 2004, pp. 5-6.

The examiner has failed to state prima facie obviousness rejections of these claims because the proposed combination does not result in the claimed inventions. As shown above, Guski does not show the limitations of the independent claims from which claims 7, 15, 23, and 31 depend. Audebert fails to cure the lack of disclosure in Guski with regard to those limitations. Thus, the examiner has failed to state prima facie obviousness rejections of claims 7, 15, 23, and 31.

In addition, the examiner has failed to state prima facie obviousness rejections of claims 7, 15, 23, and 31 because the examiner has not provided a motivation to combine the references. The examiner appears to state that Guski teaches a generating/translating method and Audebert teaches a method that a smart card can take part in generating a password to simplify the software implementation on the PC. However, the examiner has provided no logical conclusion as to how these two purported facts would motivate one to combine the references. Thus, the examiner has failed to state a motivation to combine the references and, accordingly, has failed to state prima facie obviousness rejections.

Regarding claims 4, 12, 20, and 28, the examiner states that:

As per claim 4, 12, 20 and 28, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski does not disclose expressly said translating includes inserting at least one special character.

Audebert teaches said translating includes inserting at least one special character (Audebert: see for example, Abstract Line 13-14: Audebert teaches adding the digits to the generated password). See the same rationale of combination applied herein as above in rejecting claim 7.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify adding the digits to the generated password to accommodate adding the special characters to the generated password because password format rule that requires special characters is well-known in the art (Audebert: see for example, Abstract 13-14).

Office Action of December 7, 2004, p. 6.

The examiner has failed to state prima facie obviousness rejections of these claims because the proposed combination does not result in the claimed inventions. As shown above, Guski does not show the limitations of the independent claims from which claims 4, 12, 20, and 28 depend. Audebert fails to cure the lack of disclosure in Guski with regard to those limitations. Thus, the examiner has failed to state prima facie obviousness rejections of claims 4, 12, 20, and 28.

In addition, the examiner has failed to state prima facie obviousness rejections of claims 7, 15, 23, and 31 because the examiner has not provided a motivation to combine the references. The examiner states that "password format rule that requires special characters is well-known in the art." However, the examiner fails to provide why this purported fact would motivate one of ordinary skill to combine the references. Thus, the examiner has failed to state a motivation to combine the references. Accordingly, the examiner has failed to state prima facie obviousness rejections of claims 7, 15, 23, and 31.

Regarding claims 8, 16, 24, and 32 the examiner states that:

As per claim 8, 16, 24 and 32, Guski teaches the claimed invention as described above (see claim 1, 9, 17 and 25 respectively). Guski does not disclose expressly said translating is accomplished by software running on the same computer as said target application.

Audebert teaches said translating is accomplished by software running on the same computer as said target application Audebert: see for example, Abstract, the Last Sentence). See the same rationale of combination applied herein as above in rejecting claim 7.

Office Action of December 7, 2004, pp. 6-7.

The examiner has failed to state prima facie obviousness rejections of these claims because the proposed combination does not result in the claimed inventions. As shown above, Guski does not show the limitations of the independent claims from which claims 8, 16, 24, and 32 depend. Audebert fails to cure the lack of disclosure in Guski with regard to those limitations. Thus, the examiner has failed to state prima facie obviousness rejections of claims 8, 16, 24, and 32.

In addition, the examiner has failed to state prima facie obviousness rejections of claims 8, 16, 24, and 32 because the examiner has not provided a motivation to combine

the references. The examiner refers to the same "rationale" applied regarding the rejection of claim 7; however, as pointed out above, that rationale is not a motivation to combine the references. Thus, the examiner has failed to state prima facie obviousness rejections of claims 8, 16, 24, and 32.

Furthermore, the examiner's statement makes no sense. Claims 8, 16, 24, and 32 are directed to "wherein said translating is accomplished by software running on the same computer as said target application," as claimed in claim 8. However, this limitation has nothing to do with smart cards, which is integral to the examiner's statement with regard to the rejection of claim 7. Thus, the examiner's reference back to the rejection of claim 7 makes no sense in the context of these claims. Thus, the examiner has not provided a motivation to combine the references and, accordingly, has failed to state prima facie obviousness rejections of claims 8, 16, 24, and 32.

In addition, Guski, which issued eight years ago, and Audebert, which issued six years ago, are both old relative to the rapid pace of technological development. Given the value of the claimed inventions, had the claims been obvious then one of ordinary skill already would have proposed or created the claimed inventions. Because no one has done so, claims 4, 7, 8, 12, 15, 16, 20, 23, 24, 28, 31, and 32 are non-obvious.

Similarly, the examiner must have used impermissible hindsight when fashioning the obviousness rejection. Given that no one has suggested the claimed inventions in the intervening six years since Guski and Audebert issued, except for the examiner and Applicants in this application, the examiner must have used impermissible hindsight using Applicants' application as a template when fashioning the obviousness rejections. Thus, the examiner has again failed to state prima facie obviousness rejections of claims 4, 7, 8, 12, 15, 16, 20, 23, 24, 28, 31, and 32.

In summary, the examiner has failed to state prima facie obviousness rejections because the proposed combination does not result in the claimed inventions, because the examiner has failed to state a proper motivation to combine the references, and because the examiner must have used impermissible hindsight when fashioning the obviousness rejections. In addition, the claims are non-obvious because someone would have created the claimed inventions had the proposed combination been obvious. Therefore, the

rejection of claims 4, 7, 8, 12, 15, 16, 20, 23, 24, 28, 31, and 32 under 35 U.S.C. § 103 has been overcome.

IV. New Claims 33 and 34

Applicants have added new claims 33 and 34, which depend from claims 1 and 9, respectively. Claims 33 and 34 contain the limitation that a particular preferred word creates the same password each time the preferred word is translated. Neither Guski nor Audebert show or suggest the limitations of claims 33 and 34. Thus, claims 33 and 34 should be in condition for allowance.

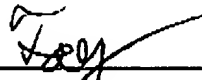
V. Conclusion

It is respectfully urged that the subject application is patentable over Guski and the combination of Guski and Audebert and is now in condition for allowance.

The examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: March 7, 2005

Respectfully submitted,



Theodore D. Fay III
Reg. No. 48,504
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicant